

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 14, 16, 18-20 and 41-44 are presently active in this case. Claims 41-45 are added, Claims 14, 16, and 18-20 are amended, and Claims 1-13 and 22-40 have been canceled without prejudice or disclaimer by way. No new matter has been added as all claim changes, including added Claims 41-45, are supported by the previously presented versions of Claims 14, 16, 18-20 and 26-31.

In the outstanding Office Action, the specification was objected to, the drawings were objected to, Claims 1, 13, 22, and 40 were rejected under 35 U.S.C. § 112, first paragraph, Claims 1 and 22 were rejected under 35 U.S.C. § 112, second paragraph, Claims 1, 3-6, 8-14, 16, 18-20, 22, 24, 25, 31, and 36-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabber, et al. (U.S. Patent No. 5,961,593, hereinafter “Gabber”) in view of Miloslavsky et al. (U.S. Published Application No. 2003/0021259A1, hereinafter Miloslavsky) and further in view of Ditmer (U.S. Patent No. 6,473,407) Claims 26-29 were rejected under 35 U.S.C. § 103(a) as unpatentable over Gabber in view of Miloslavsky) in further view of Ditmer and Kubota, et al. (U.S. Patent No. 6,480,881, herein “Kubota”).

Turning to the objection to the drawings based upon element “311” (mentioned at page 14, line 10, for example) not being shown therein, this indication as to a reference number “311” has been deleted from page 14, line 10, and from other locations in the specification as this is not a structural detail necessary to a proper understanding of the disclosed invention. Accordingly, this objection is respectfully submitted to be moot.

The further objection to the drawings as not showing various non-structural claim features is traversed.

In this respect, the “initial request not identifying the user apparatus” is illustrated

relative to the “CALL ME” request button 315 shown in Fig. 2A. This “CALL ME” button will transmit this “CALL ME” request to the information relaying system 400 as illustrated by the arrow going from 310 of system 300 to 410 of system 400 in FIG. 1, and the similar showings of FIG. 4. The request for a call is just that, the information disclosing the identity of who to call is not entered until screen 316 of FIG. 2B is displayed under control of the management computer 410. Thus, and contrary to the assertion in the outstanding Action, as much as can be illustrated as to request content is presented by this showing.

Furthermore, the recited “transferring the initial request not identifying the user apparatus from the information providing apparatus to an information relaying apparatus” is clearly included with the above noted arrow leading from the computer 310, for example, to the computer 410. the purpose of drawings is to show the structural aspect that there is information transferred from one computer to another, not to describe the information being transferred. The specification is where such non-structural explanations as to the information contents appear, not in the drawings.

Similarly, the step of “generating customer number” is a non-structural process step, not a structure that can be illustrated in a drawing. Accordingly, the requirement to illustrate such non-structural subject matter is traversed.

The rejection of Claims 1, 13, 22, and 40 under the written description requirement of the first paragraph of 35 U.S.C. § 112 is believed to be moot as these Claims have been canceled.

To the extent that Claim 14 includes the subject matter of Claim 13, and even though this claim was not included in the rejection, it is noted that the objection to the language “the initial request not identifying the user apparatus” ignores established case law that such claim language does not have to have word for word support in the specification as filed. As noted by the Board in *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Int. 1993):

The examiner contends that the rejected claims lack adequate descriptive support because there is "no literal basis for the" claim limitation "in the absence of a catalyst." Clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112.

The Board went on to note that:

We are not unmindful of the decision in *Ex parte Grasselli*, 231 USPQ 393 (Bd.App.1983) *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984), which involved claims to a process for the ammoxidation of propane or isobutane employing a catalyst "free of uranium and the combination of vanadium and phosphorus." Under the particular facts in that case, it was held that the negative limitation introduced new concepts in violation of the description requirement of the first paragraph of 35 U.S.C. 112, citing *In re Anderson, supra*. In the situation before us, it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the *concept* of conducting the decomposition step generating nitric acid in the absence of a catalyst.

Similarly, the CONCEPT that the activation of the "Call ME" button 315 is the initial act performed to get further information was disclosed in the application as filed at page 22, lines 16-18, for example. Furthermore, original specification page 22, lines 19-25, then indicate that it is not until after the transfer to the management computer 410 that the actual information required for the inquiry is input. If such information was already present when the transfer occurred, there would clearly be no need for later entry thereof.

With further regard to the disclosure of page 20, line 5-6, there is a discussion here of two possible ways to generate the customer number. However, Claim 14 does not recite that the customer number is generated "based on the transferred initial request" as urged at the bottom of page 5 of the outstanding Action. Accordingly, the assertion that there is no support in the specification for this recited customer number generation "based on the transferred initial request" is not relevant to Claim 14 or the claims dependent thereon.

The rejection of Claims 1 and 22 under 35 U.S.C. § 112, second paragraph, is believed to be moot in view of the cancellation of these claims.

Claims 1, 3-6, 8-14, 16, 18-20, 22, 24, 25, 31, and 36-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabbe in view of Miloslavsky and further in view of Ditmer. The rejection as to Claims 1, 3-6, 8-13, 22, 24, 25, 31, and 36-40 is believed to be moot as these claims have been cancelled. Similarly, the rejection of Claims 26-29 under 35 U.S.C. § 103(a) as unpatentable over Gabber in view of Miloslavsky in further view of Ditmer and Kubota is believed to be moot.

With regard to Claim 14, the base independent claim from which all of Claims 16, 18-20 and 41-45 depend, it is respectfully submitted that Gabber does not teach or suggest far more then the admitted deficiencies presented on page 7, lines 10-19 of the outstanding Action. In this regard, Claim 14 further requires at least the steps of Claim 14 that require:

said user apparatus accesses a web page provided by the information providing apparatus through a network and uses a predetermined object for initially requesting said information provided in the web page so as to initially request said information from the information providing apparatus, and

said predetermined object inputs input information relating to the request in a first state that cannot be viewed by said information providing apparatus and transfers the input information to said information relaying apparatus in a second state that cannot be viewed by said information providing apparatus.

To the extent that the outstanding Action relies on Miloslavsky to teach clicking on a “call me” button 118 described in paragraph 0099, this clicking merely causes a dialog box to appear. Thus, the user is not transferred anywhere and the information entered by the user into the dialog box will be viewable at the “information providing apparatus” as the user was not transferred from this apparatus by clicking the “call me” button 118. Accordingly, whatever else Miloslavsky teaches and suggests, it is not the subject matter required by Claim 14.

The outstanding Office Action attempts to then suggest a complete redesign and change in the operating principles of both Gabber and Miloslavsky by not having the dialog box be responsive to the call me button at the existing device but to transfer the user to a remote proxy

as in the completely dissimilar Ditmer arrangement.

It is by now well established that such a rationale that requires such a major redesign and complete abandonment of the basic operating principles of the references being modified of a reference is a prohibited piecemeal reconstruction and not an adequate showing as to motivation. See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). Moreover, the modifications proposed to the Gabber reference which already has a proxy system. In this regard, Gabber teaches:

a proxy system that performs two basic functions: (1) automatic substitution of user-specific identifiers such that server sites (e.g., web sites, junction points, intelligent portal devices, routers, network servers, etc.) within a network are prevented from determining the true identity of the user browsing (accessing, locating, retrieving, reading, contacting, etc.) the sites; and (2) automatic stripping of any other information associated with browsing commands that would allow the server sites to determine the true identity of the user browsing the server sites.¹

As previously noted, an important aspect of Gabber is that the foregoing functions are performed consistently by the proxy system during subsequent visits to the server site (the same substitute identifiers are used on repeat visits to the server site; the server site also cannot distinguish between information supplied by the user and the proxy system, thus the proxy system is transparent to the server site). See column 3, lines 2-8 of Gabber. (emphasis added).

To eliminate this feature would be a reference modification that would render Gabber unsatisfactory for its intended purpose. Such a modification is, thus, not one that is treated by the courts as adequate “motivation” to establish a *prima facie* case of obviousness. See In re Gordon, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Furthermore, Kubota does not cure the above noted deficiencies of Gabber, Miloslavsky, and Ditmer. Accordingly it is respectfully submitted that Claims 14, 16, 18-20 and 41-44 clearly patentably define over these references considered alone or together in any

¹ Column 2, line 59-column 3, line 2 of Gabber.

proper combination.

In view of the foregoing remarks, Applicant respectfully submits that each and every one of Claims 14, 16, 18-20 and 41-45 defines patentable subject matter, and that the application is in condition for allowance. Applicant respectfully requests reconsideration and reexamination of this application and timely allowance of the pending claims.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073
Raymond F. Cardillo Jr.
Registration No. 40,440

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)